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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/554,084

10/21/2005

Tristian Roger Thornhill

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EXAMINER

HOGAN, JAMES SEAN

ART UNIT

PAPER NUMBER

3752

MAIL DATE

DELIVERY MODE

02/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/554,084 | Applicant(s) THORNHILL, TRISTIAN ROGER | |
| | Examiner JAMES S. HOGAN | Art Unit 3752 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-15 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3-10,12-15,18-20, 22 and 24-27 is/are rejected.
- 7) ☒ Claim(s) 21 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 3-10 and 12-15, 18 and 19 have been considered but are moot; however, prosecution in the matter has been re-opened to address claims 21, 23 and 27 which had been omitted from previous actions. This action shall replace the Final Rejection action of July 22, 2008, and restore the Application to a non-final status.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-10 and 12-15, 18 and 19 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,147,087 to Fuchs

Regarding claims 1 and 24, Fuchs discloses (see Figure 2) a dosing device having a housing, the housing being identified by the Examiner as (items (1) and (8)), metering tube, (combined device, (9)), having a piston ((10), (11)) having an access opening (39) from the interior, the housing having a chamber (15) to hold medicament, where the metering tube extends to as dispensing position and the access opening is in

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communication with the chamber when the metering tube is filling, the opening being displaced outside of the housing.

As per claim 3, the stroke of the piston is fixed.

As per claim 4, a member (7) limits the displacement of the piston in one direction.

As per claim 5, a piston (11) is within the metering tube.

As per claim 6, the piston (11) is moveable with the metering tube (9).

As per claim 7, a stop (7) limits the displacement of the metering tube.

As per claims 8 and 9, Fuchs teaches a handheld apparatus for dispensing medicament as an atomized mist.

As per claim 10, which includes most of the apparatus features of claim 1 as discussed above, includes the housing, metering tube and medicament chamber, where and opening (39) is displaced outside of the housing when dispensing, and where the metering tube is retracted within the chamber, the opening is in communication with the chamber.

As per claims 12, 20, 22 and 25, the piston and metering tube can move together or the piston can move independently of the metering tube, depending on which stage of dispensing is occurring, thus the piston “adjusts” relative to the metering tube, the result being the piston moving in a direction relative to the metering tube.

As per claim 13 and 15 by all accounts; in a handheld inhaler, the piston (11) retracts the metering tube with itself for a filling position, thus drawing medicament from

the chamber, and then extends the tube (9) to a dispensing position and before expelling the medicament as a mist as cited above.

As per claim 14, the metering tube retracts before medicament is atomized.

As per claims 18, and 19, the opening (39) serves to both draw, and expel medicament.

As per claim 26, the apparatus of Fuchs is fully capable of performing the claimed task of retracting a metering tube (9) to a filling position drawing medicament into the metering tube from a chamber (15) extending the metering tube to a dispensing position, and expelling medicament from the metering tube, wherein the device has a piston ((10), (11)), and where movement of the piston in a first direction draws medicament into the metering tube in accordance with, and movement of the piston, which as per claim 27, slides relative to a fixed-in-position metering tube during a drawing of medicament into said metering tube in a second direction, expels medicament from the metering tube in accordance with step and where movement of the piston in the first direction results in movement of the piston relative to said metering tube.

Allowable Subject Matter

1. Claims 21 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES S. HOGAN whose telephone number is (571)272-4902. The examiner can normally be reached on Mon-Fri, 6:00a-3:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571)272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S. H./
Examiner, Art Unit 3752

/Len Tran/
Supervisory Patent Examiner, Art Unit 3752